

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

Alain LECOMPTE

Conf. 2996

Application No. 10/554,282

Group 1638

Filed October 25, 2005

Examiner M. Ibrahim

METHOD FOR OBTAINING RECOMBINANT PLANTS
OF THE CICHORIUM GENUS AND PLANTS THUS
OBTAINED

DECLARATION OF ALIN LECOMPTE UNDER 37 C.F.R. §1.1.32

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, Alain LECOMPTE, hereby declare as follows:

1. I am the sole inventor named of the above-identified U.S. application, and as the sole inventor I am familiar with the whole subject matter that is described and claimed therein.

2. My relevant background and experience is as follows:

I received an Engineer degree from the French National Horticultural School and an MsC in genetic and plant breeding from the ORSAY University of Paris in 1984.

From 1984 to 1986, I was employed by the French National Institute for Agricultural Research (INRA) as Corn breeder.

I have been employed by Vilmorin as a plant breeder since 1986. During these years I have been a pea, a cucumber, a radish and a chicory breeder for Vilmorin. Among these species, I successfully bred several new plant varieties that now lead the European Chicory market such as PLATINE, ZILIA, CRENOLINE, ECRINE & OMBLINE.

3. I have carefully studied and I am familiar with the Office Action dated of August 19, 2009.

4. I understand that the Office Action considered the present invention as "*failing to comply with the written description requirement*" because the recombinant plants that are the subject matter of specific claims (claims 8-11, presently) would not be described in the specification by features that would prove that I was actually in possession of the claimed recombinant plants.

5. I understand that, the position of the Office Action was that the claimed recombinant plants are described by phenotype only and not also by genotypic characteristics.

6. I respectfully disagree with the position of the Office Action discussed above in item 5 because, as one of ordinary skill in the art of plant breeding, I declare that describing plants by their physical characteristics of phenotype is the most usual way of defining novel plants in the field of plant breeding.

7. Illustratively, novel varieties of endive (*Cichorium endivia* L.) and chicory (*Cichorium intybus* L.) are usually described exclusively by their phenotype for various purposes, including for the purpose of getting plant protection by Plant Breeder's Rights or for the purpose of officially registering novel plants as marketable plants.

8. I hereby declare that the description of new plants exclusively by their phenotypic features always allow a person skilled in the art to discriminate between (i) the described plant of interest and (ii) all other plants, including those plants belonging to the same species as the plant of interest.

9. For the purpose of the present invention, I have succeeded in obtaining new recombinant plants that clearly distinguish from all known endives (*Cichorium endivia* L.) and chicories (*Cichorium intybus* L.), respectively, which new recombinant plants originally combine the features of exhibiting tuberous roots and indented leaves.

10. As it is disclosed in the present specification, the new recombinant plants that I have obtained may be classified in three distinct classes that have been arbitrary termed "PPI", "GPI" and "TFR/SCA", respectively, and wherein the recombinant plants of each of these three plant classes share common phenotypic features. The original and specific combination of phenotypic features that I have used allows both (i) to discriminate the recombinant plants that belong to one class among PPI, GPI and TFR/SCA from the recombinant plants that belong to each of the other classes and (ii) to discriminate the recombinant plants that belong to one class among PPI, GPI and TFR/SCA from any other plant, including from any other endive (*Cichorium endivia* L.) and chicory (*Cichorium intybus* L.).

11. Because the recombinant plants that I have obtained are highly original, their description required (i) that I used partly conventional phenotypic features of endive (*Cichorium endivia* L.) and chicory (*Cichorium intybus* L.) and

(ii) that I used partly phenotypic features that are not conventionally used for defining plants belonging to the endive (*Cichorium endivia* L.) or chicory (*Cichorium intybus* L.) species.

12. I respectfully submit that any one skilled in the art of plant breeding is able to recognize the recombinant plants described by their phenotypic features in the present specification and distinguish them from any other plants, including from any plant belonging to the endive or chicory species. I respectfully submit that the detailed phenotypic description of the claimed recombinant plants of the invention, shows to the one skilled in the art of plant breeding that I was actually in possession of these recombinant plants at least at the filing date of this Patent Application. I also respectfully submit that the figures appended in the Patent Application further support that I was in possession of the claimed recombinant plants at least at the filing date of this Patent Application.

13. I understand that the position of the Office Action was that the proof required to show that I was in possession of the claimed recombinant plants is a description of these recombinant plants by genotypic features.

14. I respectfully reiterate that the usual description of new plants consists of the disclosure of a combination of their phenotypic features.

Indeed, genotypic features are used for describing novel recombinant plants for which specific features are the result of precisely controlled genetic changes that have been brought by using genetic engineering methods.

The method for obtaining the recombinant plants that are presently claimed allows the reproducible production of recombinant plants having the phenotypic features described in the present specification. At the same time, the method for obtaining the recombinant plants of this invention does not consist of a method comprising one or more steps of genetically engineering plant material, which explains why the claimed recombinant plants are not described by physical features other than by phenotype, namely genotype features, which would not have been relevant for the present invention.

15. I declare that all statements made in this declaration of my knowledge are true and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code and that such willful false statements may

jeopardize the validity of the application or any patent issued thereon.

Signed at La Mennire France



Alain LECOMPTE

this 4th day of November 2009